IN THE

Supreme Court of the United States.

GEORGE E. VANDENBURGH,
Plaintiff,

vs.

CONCRETE STEEL COMPANY,
Defendant-Petitioner.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

To the Honorable the Chief Justice of the United States and the Eight Associate Justices Thereof, Constituting the Supreme Court of the United States:

Your petitioner, Concrete Steel Company, respectfully represents:

I. That it is a corporation organized under the laws of the State of Delaware; that on or about the 7th day of February, 1917, George E. Vandenburgh, plaintiff herein, filed his Bill of Complaint in the District Court of the United States for the Southern District of New York, alleging infringement of his reissued Letters Patent, No. 14,182, dated August 15, 1916; and thereafter your petitioner filed its answer thereto, and such proceedings were had that the cause came on for trial before the Hon. Charles M. Hough, a Circuit Judge duly assigned to hold said District Court, and upon due consideration the said District Court ordered that the Bill be dismissed.

II. Thereafter an appeal was taken to the Circuit Court of Appeals for the Second District before their Honors Judges Ward, Rogers and Manton, holding the court, and such proceedings were had that the court ordered the decree of dismissal to be reversed and the cause to be referred to a Master to take account of profits and damages.

III. Such proceedings were had before the Master that on the 24th day of November, 1920, he reported to the court that there was due from my defendant to the plaintiff the sum of $15,918.33; and thereafter exceptions were duly taken and the matter came before the District Court for the Southern District of New York, by which the Master's order was confirmed.

Thereupon an appeal was taken to the Honorable the Circuit Court of Appeals, for the Second Circuit, and such proceedings were had that on or about the 14th day of December, 1921, the Circuit Court of Appeals affirmed the decree of the District Court in all things.

IV. Your petitioner further represents that there have been further proceedings based upon the reissued Letters Patent set out in the Bill of Complaint in this case, but that no other of said proceedings has resulted in a money judgment against any of the defendants save only your petitioner and that such other proceedings have been as follows:

A. A suit in the Western District of Pennsylvania in which on or about the 24th day of July, 1918, his Honor Judge Charles P. Orr ordered the Bill of Complaint to be dismissed. An appeal was thereupon taken to the Circuit Court of Appeals for the Third Circuit wherein the order of the District Court was affirmed. The decree of the District Court held the Letters-Patent to be invalid and of no effect in law, and also held that the defendant did not infringe. The Circuit Court of Appeals for the Third Circuit held (on February 19,

1920) that the defendant did not infringe and did not examine the question of validity.

B. A suit was filed in the Northern District of Ohio, Eastern Division, against the Truscon Steel Company, and such proceedings were had that on or about the 23rd day of September, 1920, his Honor Judge Westenhaver, sitting in the said District Court, ordered the Bill of Complaint to be dismissed. Thereupon an appeal was taken to the Circuit Court of Appeals for the Sixth Circuit, which appeal has been argued and submitted, but has not yet been determined. The decree of the District Court held that the Letters-Patent in suit were invalid, after a full examination of the record; and no holding has been made by the Circuit Court of Appeals for the Sixth Circuit.

C. On or about the 15th day of June, 1921, a suit was filed against the United States in the Court of Claims for infringement of the Letters-Patent in suit in this case, alleging that there was due and recoverable by the plaintiff from the United States the sum of $500,000. The said suit is at issue and testimony therein is due to proceed, but it has not yet been submitted to the court for determination.

V. Your petitioner is advised and believes that the determination of the Honorable the Circuit Court of Appeals in this case is final, and is erroneous, in the following particulars:

(1) In holding the said Letters-Patent in suit to be valid;

(2) In holding the said Letters-Patent in suit to be infringed;

(3) In not considering the references cited by the defendant, which have been found adequate in all other courts save this to annul the patent;

(4) In basing its conclusion of validity upon the isolated statements of a single witness testifying con-

cerning a construction of his own, which the Circuit Court of Appeals in the Third Circuit has held did not infringe the Letters-Patent in suit; and in applying the statements of the witness to the said Letters-Patent and not restricting it to the non-infringing construction to which he testified;

(5) In not holding the said reissued Letters-Patent to be void and of no effect in law because fraudulently reissued ten years after the issue of the original Letters-Patent, for the purpose of broadening the scope thereof and to cover constructions not covered by the said original Letters-Patent;

(6) In not affirming a decree of the District Court holding said reissued Letters-Patent to be restricted to a rigid construction only; and, therefore, not to be infringed by the defendant, whose construction is admittedly collapsible;

(7) In not ordering the Bill of Complaint to be dismissed with costs in all courts.

VI. Your petitioner further represents that the plaintiff in this case is a man of no means or substance and is in fact financially wholly irresponsible; and that if the judgment in this case be collected an order of restitution will be nugatory; inasmuch as your petitioner is informed, and verily believes, that a substantial part of the judgment is due and payable to counsel for services, which payments the plaintiff will be unable to make unless the judgment be collected; and that so much thereof will be expended in the payment of these fees and expenses that if an order of restitution shall be made after a determination of the application for the writ hereinafter referred to, the plaintiff will be unable, by reason of lack of means, to comply therewith, even if service could be obtained on him in such way as to be effective, he being, as your petitioner is advised and believes, a non-resident of the Second Circuit, residing in Washington, in the District of Columbia.

VII. Herewith your petitioner files—

Certified copies and additional copies sufficient for the use of the court of the Transcript of Record upon the first appeal, and also of the Transcript of Record upon the second appeal;

Printed copies of the opinion of the Circuit Court of Appeals for the Second Circuit on the first appeal, and also on the second and final appeal;

Printed copies of the Opinion of his Honor Judge Orr in the Western District of Pennsylvania in the suit of this plaintiff against the Electric Welding Company;

Printed copies of the Opinion of the Circuit Court of Appeals for the Third Circuit upon affirming the decree of the District Court for the Western District of Pennsylvania in the said suit;

Printed copies of the decision of his Honor Judge Westenhaver in the District Court for the Northern District of Ohio, Eastern Division;

Printed copies of the petition filed by this plaintiff against the United States in the Court of Claims.

VIII. Wherefore your petitioner prays that your Honors will issue to the said Circuit Court of Appeals for the Second Circuit of your writ of certiorari, commanding it to send to this court the record of proceedings in the cause that the same may be examined here, and that right and justice may be done.

And your petitioner prays that your Honors will stay the proceedings in the District Court in the Second District of New York until such time as your Honors may have acted upon this application, and upon the return to the said writ of certiorari, if the same shall be issued.

And your petitioner will ever pray.

CONCRETE STEEL COMPANY,
Petitioner.

By

THOMAS J. JOHNSTON,
Of Counsel.

IN THE
SUPREME COURT OF THE UNITED STATES.

CONCRETE STEEL COMPANY,
Petitioner,
v.
GEORGE E. VANDENBURGH,
Respondent.

October Term
1921.

MEMORANDUM UPON THE APPLICATION FOR A STAY AND FOR THE WRIT OF CERTIORARI TO THE SECOND CIRCUIT COURT OF APPEALS.

So far as the application for a stay is concerned, we are authorized by Mr. Edwards, solicitor for the plaintiff, to say to the Court that the preservation of the *status quo* until the Court shall act upon the application for *certiorari* is not opposed by the plaintiff.

This is a patent suit coming up in the ordinary way, briefly as follows: There was a bill and answer. The District Court held that there was no infringement (Judge Hough presiding) and that he need not consider intervening rights or the validity of the reissued letters-patent, which had been reissued ten years after the original and seven years after the plaintiff discovered the supposed errors in it, and for the purpose of broadening the claims. He held also that he need not consider validity since the letters-patent from their nature and position in the art were restricted to a *rigid* construction, whereas the defendant's structure was a *collapsible* construction. He held also that plaintiff's patent did

not disclose or describe the invention which he is now attempting to claim.

On appeal, the Second Circuit Court of Appeals reversed Judge Hough's decision, held the patent to be valid and infringed, and directed a reference to a Master.

Another suit was then pending in the Western District of Pennsylvania and intermediate of Judge Hough's decision and that of our Circuit Court of Appeals, Judge Orr held in that suit that the letters-patent in suit were invalid in view of the prior art and also that the structure of the Electric Welding Company, defendant in that case, did not infringe. Appeal was taken to the Third Circuit Court of Appeals, which held that Judge Orr's opinion was correct as to infringement, and practically, that it need not decide the question of validity since the dismissal must be affirmed in any event. It did not consider the references or the prior art, or rule at all upon the question of validity or scope, except in a minor matter concerning the particular shape of the teeth of the concrete reinforcing structure described.

Under a decision of the District Court for the Southern District of New York, speaking by Judge Hough in *Victor T. M. Co.* v. *Sonora Phono. Co.*, 188 Fed. Rep., 330, the failure to reverse the decision of Judge Orr on the question of invalidity leaves that the law of the Third Circuit, *i. e.*, that the patent is invalid; so that the competitors of the defendant in this case are free to use the patented structure exactly, as well as in the modified forms which have been held not to be infringements.

Another suit was filed in the Northern District of Ohio in which Judge Westenhaver, while holding that he could dispose of the case on the question of infringement, declined to do so, and considered very fully the prior art, the decision of the Circuit Court of Appeals for the Second Circuit, and Judge Hough's opinion. After mature consideration, he followed Judge Hough's opinion and explained that the Second Circuit Court of Appeals had not investigated the question of validity; and that on the references before it, its decision should

have been that the patent was invalid. That case has gone to the Circuit Court of Appeals for the Sixth Circuit and has been heard there, but the opinion has not yet been rendered.

Another suit on the letters-patent involved here has been filed in the Court of Claims against the United States in which the *ad damnum* is set at $500,000. No substantial progress has been made in that suit. If the *certiorari* be granted in this case, it will settle the important issue of validity for that, as well as the conflict of decision in the lower courts of the United States. As the question will come here eventually, either upon this proceeding or by direct appeal from the Court of Claims, this Court must deal with it at some time, and it has seemed to us the short and simple way to settle the issue of validity now. If the patent is invalid, as held by Judge Westenhaver and Judge Orr, then the United States should not be put to the expense of defending the suit in the Court of Claims.

After all of these proceedings had been instituted and some of them decided, the Master in this case filed his report, awarding $15,918.33 profits. The report was confirmed by the District Court; the defendant has given a bond fully covering its liability; and the decision below has been now confirmed by the Circuit Court of Appeals in a decision by Judge Mayer. Judge Mayer was not upon the bench on the former appeal, and of course accepted the doctrine of the opinion formerly filed in the case.

Copies of all of these opinions referred to, and a copy of the complaint in the Court of Claims, have been printed and are appended to this brief. Copies of the Transcripts of Record upon both appeals to the Circuit Court of Appeals of the Second Circuit in this case are also filed.

So far as a disposition of the cases is concerned on this application instead of an application made at an earlier date immediately after the filing of the original opinion of the Circuit Court of Appeals holding the

patent valid and infringed) that seems to be disposed of by *Hamilton Brown Shoe Company* v. *Wolf Bros. & Co.*, 240 U. S., 251, in which this Court held that a sufficient reason for not taking up the matter on *certiorari* at the earlier time was that the decree was not final. We understand this to mean that the Court will discuss all the questions brought up by the record, if it shall elect to issue its writ.

Subject Matter of the Suit.

This is a concrete reinforcing structure built of iron to be embedded in the concrete. All the Courts have held that the art is an old one and a full one. The natural corollary of this is that any patent issued in the art and purporting to cover details must necessarily be of restricted scope. We believe that this requires no citation of authority.

Reissue Defense.

The original patent is No. 841,741, issued on January 22, 1907. The reissue is No. 14,182, and was issued August 15, 1916, practically *ten years* after the patent had been issued in the first instance. All of the reissue decisions of this Court at least since Miller *v.* The Brass Co., 104 U. S., 352, have held that long delays in reissues were not to be countenanced; and that two years was a reasonable limit, beyond which full explanation must be made of delay.

No explanation whatever was given by the plaintiff for his delay. The oath which he filed with his application for reissue is found on page 122 of the Transcript of Record on the first appeal. It abounds with conclusions of law and is singularly deficient in statements of fact, other than those which appear from the face of the record itself; and not a word is said in the whole oath of *any* reason why the alleged errors were not immediately obvious "upon taking the patent from its envelope," as

was once said by this Court. It abounds also in misstatements of fact in that it says that the new claims which it has substituted and for which the reissue was granted are more limited than the original claims;whereas every Court which has dealt with these new claims has held them to be invalid, because not only broader than the original, but broader than the plaintiff's invention; and as an attempt to cover something which he did not show or describe. The oath also stated, (see page 124) "that as soon as said errors came to his knowledge and attention, he applied for this reissue;" whereas when he went upon the stand in the Electric Welding suit heretofore referred to, he testified, see page 21 of the Transcript of Record on the first appeal in this case, at Q. 32, that he discovered the errors "in 1909, along about that time;" whereas the reissue application was filed in 1916.

In a man of a higher grade of intelligence, and less dependent for light and leading upon the voice of counsel, the conflict of statement might be given a very harsh construction; and in any event, it is sufficient to justify holding the reissue invalid *in toto*.

Defendant's Intervening Rights.

The last decision of this court of Appeals (Judge Mayer's) holds that defendant had no intervening rights; but Judge Hough said that he "did not consider intervening rights," and the original decision by Judge Ward of the Circuit Court of Appeals does not consider them either; see page 138, Transcript on first appeal.

That defendant has these intervening rights is clear from the Exhibit D (beginning at page 126 first Transcript) disclosing the correspondence between Mr. Havemeyer, the defendant's president, and Mr. Griffin, the plaintiff's solicitor, concerning the patent. This was initiated before the application for reissue was filed, and the claim of infringement and a threat of suit were made.

Defendant replied that it did not infringe, and no suit was brought upon the original letters-patent. The very ground of the defense of non-infringement was that defendant's structure *was collapsible*, whereas the letters-patent in suit distinctly claimed to be and was in fact "rigid"; and also that the plaintiff's structure formed "a truss within the concrete." As defendant's structure could in no sense be called a truss or rigid, the ground of non-infringement was clearly reasonable.

Thereafter the application for reissue was filed, as held by Judge Hough, "to catch manufacturers like defendant," who were using collapsible structures and selling them. Incidentally it may be said that the plaintiff in the case has never made, used or sold a pound of the reinforcing described in his patent; nor so far as the record discloses has anyone else; Judge Hough held (p. 135) "there is no proof at all that plaintiff has contributed to this growth" in the concrete art. The Master holds, page 216 Transcript on second appeal, "Vandenburgh never made or sold any concrete reinforcement and never exploited the patent in any way." These holdings are all that have been made; but in none of the suits has any testimony been introduced showing any use of the actual structure patented by the plaintiff. It appears to be conceded that he made none.

We therefore have this situation presented to the Court: There is an apparent radical difference of opinion among the judges as to the validity of the patent in suit; but no court which has examined and discussed the prior art disclosed by the references in this record has held it to be valid. The prior art is admitted to show all of the elements shown in the defendant's patent; see for example the Considere patent, page 65 Transcript on first appeal, showing the vertical bars and the so-called spiral or helix; the Eason patent, page 63 former Transcript, showing the vertical bar, independent rings and the kerf and spur attachment; the Clark patent, page 60 old Transcript, showing the kerf and spur in a somewhat different form, with wires held in place to a vertical bar

thereby; the Norwood patent, page 57 old Transcript, showing the identical form of kerf and spur for securing wires to longitudinal bars used in a screen employed in concrete work; the Prescott and Bennett patent, page 55 old Transcript, which shows the helix, the bars (here laid horizontal) and the kerf and spur attachment. This also is a screen used in concrete work every day.

The real origin of the reissue, in addition to defendant's collapsible structure, is undoubtedly to be found in the McClure patent, coming out a few months after plaintiff's; see page 94, old Transcript.

Now the result of the whole matter is that these persons in other jurisdictions, active competitors of the defendant in this, are free to use the patented structure if they shall see fit, whereas the defendant cannot do so, being under injunction. Furthermore, these other users in other jurisdictions are free from contribution, whereas the defendant has given a bond for $17,435.00 to secure the judgment in this case. If the decision of the Circuit Court of Appeals in this case be upheld, the claim against the United States for $500,000. is not unreasonable and may possibly be allowed; and yet this will be for a piece of paper, since it cannot be pretended that the defendant's idea was an invention at all, or ever went into use.

The original opinion of the Circuit Court of Appeals in this suit does not discuss the prior art and seems to have overlooked it entirely. The Vandenburgh patent does not cover a spiral; nor did Vandenburgh invent that, as is shown clearly in the prior art.

The Question of Damages.

It is unnecessary to consider the question of damages because the Master has held (and all of the Courts have sustained him) that the plaintiff had suffered no damages, because he had never made or sold the structure and had therefore lost no sales; and because there was no testimony in the case from which a reasonable royalty could be deduced. No other conclusion could be reached

on the record in this case. The testimony was in hopeless conflict and on the part of the plaintiff of the wildest and most extravagant character, ranging from eight to thirteen dollars a ton royalty on a structure on which the engineering assistant of the United States Steel Corporation said that five dollars a ton was a very satisfactory *total* profit; which of course included the sale of the iron work *per se*. There was other testimony, but as the three tribunals below, the Master, the District Court and the Circuit Court of Appeals, have reached the same conclusion about it, it seems unnecessary to refer to it before this Court, certainly on this preliminary examination of the case.

Profits.

As to defendant's profits, all of the Courts which have dealt with them have fallen into the same very grave and very serious errors in that, while apparently recognizing its controlling force, they have failed utterly to apply the doctrine of the case Westinghouse *v.* Wagner, 225 U. S., 604. The Master's holdings on that subject are in flat conflict with one another; as he says in one place that the case is one falling under class (d) of Westinghouse *v.* Wagner, and "it was the duty of the plaintiff to apportion the profits between those due to the patented feature and those attributable to the unpatented part, or to show that such apportionment was impossible by reason of the defendant's acts," further holding that "the plaintiff has made no effort to work out an apportionment or to show that one was difficult or impossible"; see page 210, Transcript on second appeal; and on page 212 "the plaintiff has wholly failed to sustain the burden of making such apportionment"; but in another place, he makes the same mistake as the Circuit Court of Appeals in applying the testimony of Mr. Cummings in the Electric Welding case to the plaintiff's claimed structure, whereas Mr. Cummings dealt only with one element, and that old in the art; that is the difference between hoops

and a spiral, which Vandenburgh did not invent and which his claim does not cover; for the Master further goes on to hold that the case comes within class (b) of Westinghouse *v.* Wagner, where "the patented feature gives the whole value to the structure"; see page 215, middle.

He thus fails (and the Courts have followed him in failing) to distinguish

(a) Between the profits from the sale of ironwork, as distinct from the profits due to the plaintiff's invention; and

(b) Between the profits due to the plaintiff's invention and those due to the collapsibility of the structure, which the Circuit Court of Appeals in its first opinion decided was an improvement upon the plaintiff's structure, introduced *by the defendant.*

The result of these findings is to set at naught the whole line of distinctions found in Westinghouse *v.* Wagner, and to make the defendant liable for its profits on the sales of ironwork, and for those due to its collapsible improvement, so-called, in addition to those due to the plaintiff's patent; of which not a single sale was ever made either by the plaintiff, or by the defendant, or by anyone else, so far as this record discloses. The situation is not the same as the one presented to this Court in Westinghouse *v.* Wagner, because at that time the careful distinctions made in that case and the course of practice outlined in general by this Court in accounting cases had not been made, and the plaintiff in that case was not in a position to apply the instructions of this Court. In the instant case, they had been in the books for about six years and there was no reason why the defendant should be called on to give any evidence on these questions until the plaintiff had shown according to the doctrine of Westinghouse *v.* Wagner either (A) that such an apportionment was impossible; or (B)

that it had been prevented from making it by the act of the defendant.

Both of these contentions are disposed of by the Master, the first one as already indicated; and as to the second one (regarding the conduct of the defendant) the Master says, page 221, second Transcript "the defendant has shown in the proceedings before me no disposition to cause unreasonable delay or in any way harass or impede the plaintiff;" while a casual examination of the record will show that every call for information from the defendant's books has been fully and fairly met, and there is not even an exception or objection raised by the plaintiff as to anything which the defendant has done. It is simply a plain case of a failure to prove the plaintiff's case, and a refusal by the Master and the courts below to be guided by the opinion of this Court.

CONCRETE STEEL COMPANY,

by

THOMAS J. JOHNSTON,
Its Counsel.

L. E. VARNEY,
T. J. JOHNSTON,
E. G. CURTIS,
EMERY, VARNEY, BLAIR & HOGUET,
Of Counsel.

New York, December 31, 1921.

APPENDIX A.

Opinion.

UNITED STATES CIRCUIT COURT OF APPEALS.

FOR THE SECOND CIRCUIT.

No. 172—October Term, 1918.

Argued March 3, 1919. Decided April 16, 1919.

GEORGE E. VANDENBURGH,
Plaintiff-Appellant,

vs.

CONCRETE STEEL COMPANY,
Defendant-Appellee.

Appeal from the District Court of the United States for the Southern District of New York.

Before WARD, ROGERS *and* MANTON, *Circuit Judges.*

JAMES H. GRIFFIN, *for Plaintiff-Appellant.*

LUCIUS E. VARNEY, *for Defendant-Appellee.*

WARD, *Circuit Judge.*

U. S. Reissued Patent 14182 to George E. Vandenburgh for a concrete reinforcing bar was held void for want of invention by the District Court for the Western District of Pennsylvania in the suit of *Vandenburgh* v. *Electric Welding Co.*, while the court below dismissed the bill in this case against the Concrete Steel Company for non-infringement. Both courts held that the original patent did not contemplate collapsibility of the structure because the spiral coil was described as rigidly fixed by kerfs and spurs on the reinforcing bar. For this reason it was held that claims 1 and 2 of the reissue which were

intended to cover collapsibility of the structure were invalid as too broad. We agree in this conclusion.

But claim 3 of the reissue is literally the same as claim 3 of the original patent and claim 5 of the reissue is literally the same as claim 4 of the original patent. These claims should be construed consistently with the specifications, which are also literally the same in each patent, as meaning that the spiral coil is rigidly connected with the longitudinal bar at each point of contact. So construed the claim describes a continuous spiral rigidly and integrally connected with kerfs and spurs in the bar constituting a trusslike structure within the body of the concrete resisting lateral and longitudinal strains and which can be more cheaply manufactured than if the spiral were riveted or welded to the bar at each point of contact.

The defendant's witness Cummings frankly admits that this form of reinforcing structure was new in cement work and has come into general use. The fact that claims 1 and 2 of the reissue are invalid as too broad does not invalidate claims 3 and 5, *Gage* v. *Herring*, 106 U. S., 640, 646. The defendant's structure when set up to receive the concrete is exactly the same as plaintiff's except that the spiral coil is not rigidly fixed by kerfs and spurs on the bar. This enables the structure to be collapsed when not in use, a commercial improvement for purposes of shipment but which does not justify the defendant's appropriation of the plaintiff's structure.

The decree is reversed with half costs to the plaintiff.

APPENDIX B.

UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SECOND CIRCUIT.

GEORGE E. VANDENBURGH,
Plaintiff-Appellant,

against

CONCRETE STEEL COMPANY,
Defendant-Appellant.

Before ROGERS, MANTON and MAYER, *Circuit Judges.*

CARLOS P. GRIFFIN and O. ELLERY EDWARDS for plaintiff.

LUCIUS E. VARNEY, THOMAS J. JOHNSTON and MANVEL WHITTEMORE for defendant.

Appeal from final decree of the District Court of the Southern District of New York in favor of plaintiff. Both parties appeal.

MAYER, *Circuit Judge*:

This is the ordinary patent infringement suit which now comes here on appeal from a final decree adjudging that plaintiff recover from defendant profits in the sum of $15,918.33 with interest from the date of the Master's report.

Originally, the District Court dismissed the bill for non-infringement but the decree was reversed for the reasons stated in 258 F. R. 143.

Thereafter, in due course, the usual interlocutory decree was entered, *inter alia,* referring the accounting to a Special Master. The Special Master reported that plaintiff was entitled to recover profits but not dam-

ages. The District Court sustained this report. Both the District Judge and the Master wrote opinions fully and carefully discussing the questions involved.

1. The patent has been considered by several courts, *Vandenburgh* v. *Electric Welding Company*, 259 F. R. 579, 263 F. R. 95, *certiorari* denied 253 U. S. 497, *Vandenburgh* v. *Truscon Steel Company*, opinion of District Court for the Northern District of Ohio, Eastern Division dated September 23, 1920; and there have been differences of opinion.

The law of this case, however, is that set forth in this Court's opinion per Judge Ward in 258 F. R. *supra*. The gist of the case may be recalled by the following quotation:

> "These claims * * * (3 and 5 of the reissue) * * * should be construed consistently with the specifications, which are also literally the same in each patent, as meaning that the spiral coil is rigidly connected with the longitudinal bar at each point of contact. So construed the claim describes a continuous spiral rigidly and integrally connected with kerfs and spurs in the bar constituting a trusslike structure within the body of the concrete resisting lateral and longitudinal strains and which can be more cheaply manufactured than if the spiral were riveted or welded to the bar at each point of contact.
>
> The defendant's witness Cummings frankly admits that this form of reinforcing a structure was new in cement work and has come into general use. * * * The defendant's structure when set up to receive the concrete is exactly the same as plaintiff's except that the spiral coil is not rigidly fixed by kerfs and spurs on the bar. This enables the structure to be collapsed when not in use, a commercial improvement for purposes of shipment but which does not justify the defendant's appropriation of the plaintiff's structure."

Defendant's collapsible feature thus did not avoid infringement but merely added a commercial improvement for purposes of shipment.

It is contended by defendant that the case is one for apportionment of profits and that Court and Master erred when they ascribed (as did plaintiff) the whole value of defendant's structure as a commercial article to the Vandenburgh patent feature.

The theory of defendant is that all or, in any event, part of the commercial value of defendant's structure was due to its collapsible feature and, but for this, the structure would not have been salable. Therefore, defendant contends that when plaintiff has not adduced any testimony that the structure is salable when not collapsible or of the profits due to collapsibility, plaintiff has failed to carry the burden of proof cast upon him. *Westinghouse* v. *Wagner Mfg. Co.*, 225 U. S. 604.

Defendant did not introduce any testimony in respect of apportionment. It relied on its contention that because plaintiff failed to produce testimony upon which an apportionment could be based, he would be entitled to nominal damages only.

It may be assumed from the testimony of plaintiff's witnesses that if the structure were shipped there would be a saving in freight. It may, also, be assumed that in some instances, owing to competitive conditions, the determining factor in a sale might be this saving. Yet, it is entirely plain that there never would have been any sale whatever without this Vandenburgh feature. It was the Vandenburgh "form of reinforcing structure" infringed by defendant, which was new in the art. The advantage according to the expert Thayer, over the method, in the prior art of riveting or wiring is that "the method of wiring used up a good deal of the section of the bar. It was that way and riveting is also expensive."

Thayer also mentioned the collapsible feature as a part of what he called the "Vandenburgh method," but, with this, we do not agree, in view of our former decision.

It is entirely clear, however, that defendant would never have sold a dollar's worth of its devices had it not availed of plaintiff's patent. The cheapness of manufacture was due to plaintiff's disclosure, which, therefore, created defendant's device as a commercial commodity. Because, then, in some instances, the additional feature of collapsibility saved freight, it cannot be said that this feature placed the burden of showing apportionment on plaintiff.

The test is whether the invention of the patent gives the whole value to the infringing device. Obviously, it must, in a case where the sale of the article would be impossible without availing of the disclosure of the patent and, where the additional feature had no relation to the structure, *cua* structure, or to its shipment as such but only to reduced expense in transportation, accomplished by means which in no manner changed the character of the structure when used for the purposes for which it was designed.

If, therefore, the saving of freight was an accounting element, the burden of so showing was on defendant.

Westinghouse v. *Wagner Mfg. Co., supra.*

This is peculiarly illustrated in this case.

Barbour, who is in charge of the details of the sales in defendant's New York office, was called by plaintiff. He testified as follows:

> "Q. 41. In any event, these spirals are shipped collapsed, connected to some longitudinal bars, you understand that to be the subject matter of this suit? A. I understand that to be the subject matter of this suit, but the spirals are not all shipped in that way, not in my territory.
>
> Q. 42. What percentage are shipped in any other way? A. You mean the territory I know about, that is within New York City or a radius of 25 miles of New York City?

Q. 43. Where you are selling? A. In New York City or a radius of 25 miles from New York, they ship what we call field assembled; that is, the coil wire is shipped, it is coiled to diameter and shipped separate as a coil, then the angles are punched and shipped separate, that is on account of a restriction.

Q. 44. Assembled by you or assembled by the contractor? A. By the contractor on the job, what we call field assembly; that is on account of a restriction, I think it is, Metal Lathers Union; they won't allow us—they won't allow I don't know as I should say 'us,' but they won't allow the contractors to use spiral in any other way in New York City or within a radius of 25 miles of New York."

The foregoing shows that a considerable business was done by defendant without the collapsible feature because of the "Union" restriction and, thus, destroys any contention that collapsibility was, in all instances, an indispensable requisite.

From what has been said, *supra*, there was no obligation upon plaintiff to apportion the profits between the Vandenburgh features and the prior art. There was no standard of comparison and, on the evidence in this case, there was no occasion for that reason to apportion profits. See *Philadelphia Rubber Works Co.* v. *U. S. Rubber Reclaiming Works,* F. R. , recently decided by this court.

2. On the facts in the case as clearly set forth by the Master and approved by Judge Knox, there was no evidence which afforded any basis for fixing the amount of a reasonable royalty. We think this question was wholly one of fact to be disposed of on settled principles which do not call for exposition.

3. Plaintiff urges that he is entitled to recover interest as six per cent as to each item of profit from the date thereof as set forth in defendant's account. There

is no evidence of wanton infringement. The mere fact that the courts held different views as to the claims of the patent is sufficient to negative any such suggestion.

Metallic Rubber Tire Company v. *Hartford Rubber Works Company,* F. R. .
The Philadelphia Rubber Works Co. v. *U. S. Rubber Reclaiming Works, et al.*

In an infringement case, where there is a genuine controversy, it is settled in this circuit, that interest runs from the filing date of the Master's report.

Oehring against *Fox Typewriter Co.,* 251 F. R. 584.
Metallic Rubber Tire Co. v. *Hartford Rubber Works Company, supra.*
The Philadelphia Rubber Works Co. v. *U. S. Rubber Reclaiming Works, et al., supra.*

4. Plaintiff, contrary to defendant's contention, was not guilty of laches and there were no intervening rights. Plaintiff has recovered profits only from August 15, 1916, the date of the reissue patent.

The decree is affirmed without costs on this appeal.

In view of the result, there is no occasion to deal further with the Master's motion to dismiss or affirm as to his allowance.

APPENDIX C.

Opinion of Judge Orr.

IN THE

DISTRICT COURT OF THE UNITED STATES.

FOR THE WESTERN DISTRICT OF PENNSYLVANIA.

GEORGE E. VANDENBURGH, vs. ELECTRIC WELDING COMPANY.	No. 127 May Term, 1917. In Equity.

ORR, *J.*

The plaintiff who is the patentee and owner of re-issued patent No. 14,182, dated August 15, 1916, for a "reinforcing-bar," filed his bill, against the defendant charging that the defendant has infringed plaintiff's rights under said re-issued patent and demanding an accounting. The bill is in the ordinary form. The answer set up that the patent is invalid and further that if the patent could by any means be adjudged valid, yet defendant has not and does not use the device of the patent and therefore does not infringe any of plaintiff's rights granted to him by the said patent. By stipulation filed claims one, two and three of the re-issued patent are involved.

The original patent is No. 841,741 and was issued January 22, 1907, upon an application filed May 9, 1906. The drawings attached to the re-issued patent are the same as those attached to the original patent, except that they are upon a smaller scale. The specification of the reissued patent is for all purposes necessary for the con-

sideration of this case, the same as the specification of the original patent. The only difference between the two patents is in the matter of the claims which for the present need not be considered.

The patent relates to the art of reinforcing concrete. It is one of an exceedingly large number in that art, many of which have been submitted to this court in other cases in which the art has received consideration. In none of these cases has there been the same evidence of prior uses or the same evidence as to the state of the art at and immediately before the time when the various patents under consideration were applied for. In the present case the evidence of the state of the art at and before the time of the application by the plaintiff for his original patent is more voluminous than in any case that has been brought hitherto before this court. The evidence in this case shows that the study of methods of reinforcing concrete has been intense and widespread for years. The object of reinforcement is to give strength in those parts of the concrete structure where strains may be expected. Building operations close to the public streets and bridges and road construction on highways and along railroads have made the general public familiar with the facts that long rods and bars, short rods and bars, rods and bars with angles or with curves or loops, wire meshwork and meshwork of other materials are all sometimes severally used for that purpose. The calculation of stresses by constructing engineers and the introduction into the concrete mass of reinforcing members where such stress is likely to be found are matters in which the public is so largely interested that serious consideration should be given to the question of the validity of the patent, although as between the parties to the litigation the case may be disposed of because infringement is not found.

It is not necessary to give a pictorial illustration of the plaintiff's structure. It suggests the pen holder rack which for many years has been found on writing desks and which consists of a horizontal spiral coil of wire

fastened to a base by means of which these separate coils are maintained in a general vertical position.

We refer now to the specification and find that the patentee sets forth the nature and object of what he calls his invention in the following language:

> "This invention relates to a reinforcing-bar particularly adapted for cement and concrete construction wherein the bar is embedded in the plastic body to be supported thereby.
>
> The invention has for an object to provide a reinforcing-bar with one or more spirally-disposed soils secured to the bar so as to provide an extended area of contact adapted to resist strain longitudinally and laterally of the bar and to form a truss within the body of concrete or other plastic material which provides the maximum of supporting strength in the arch or surface to be formed.
>
> Other and further objects and advantages of the invention will be hereinafter set forth, and the novel features thereof defined by the appended claims."

He emphasizes his preferred construction as being "thus providing a construction in which all lateral pull or strain of the coil is avoided, owing to the equalization thereof by the oppositely-extending coils and the tendency of the coils to move or flatten toward the face of the bar resisted." He mentions a preferred means of securing the coils to the bar by setting the coils within kerfs and holding them therein by means of integral spurs "which are forced downward upon the coils when inserted and permanently retain them in position."

It was urged at the trial that one of the special advantages of the plaintiff's construction was its collapsibility and therefore its suitability for transportation from the place of manufacture to the place of use. The structure of the patent is not collapsible. The quotations above indicate it. If the integral spurs are *forced* down upon the coils and *permanently* retain them in position there

can be no collapsibility. The bar to which the coils are attached is a spacing member in its relation to the plaintiff's structure. In its relation to the concrete structure it may or may not be a reinforcing member dependent upon an engineer's determination of stress to be relieved. The reinforcing bar of the patent, however, embraces both the helicoidal coil and the bar just referred to which may be called the spacing member. The collapsibility was not a feature of the structure of the plaintiff under the original patent is clear because the first two claims of that patent require the spiral coil to be "rigidly secured" to the bar and none of the other claims indicate a different relation between the two. In the re-issued patent the first two claims of the original patent have been eliminated. It will be noticed in reading the three claims of the re-issued patent which are in suit, as hereinafter quoted, that the first two require the spiral coil to be "permanently secured" to the bar, and that the third indicates it because it required the overlapping spur to retain beneath it a convolution of the coil. The three claims are as follows:

> "1. A concrete reinforcing consisting of a bar having a plurality of integral spurs, and a spiral coil permanently secured thereto by having the spurs bent down on the several coils, the coils extending beyond and free of the bar at the opposite side therefrom to the securing point.
>
> 2. A concrete reinforcing consisting of a bar having integral means to secure a coil thereto, and a spiral coil permanently secured to the bar in each convolution and extended beyond and free of said bar at the opposite side therefrom to the securing point.
>
> 3. A reinforcing-bar provided upon one edge with a series of kerfs each having an integral overlapping spur, and a coil disposed in said kerfs, each convolution thereof being retained beneath one of said spurs."

Being satisfied that collapsibility was not a feature of the device of the first patent, the court is equally satisfied that if collapsibility may be found to be disclosed in the re-issued patent, then the re-issued patent was broader than the original and should not have been granted. The evidence clearly discloses that intervening rights have arisen; therefore the re-issued patent must be held invalid as being broader than the original to the extent at least that there is a disclosure therein of collapsibility in the plaintiff's structure.

However, it is unnecessary to decide this case upon the question as to whether or not the plaintiff's structure is collapsible or whether it is rigid or otherwise permanent in the relations between the coil and the bar. This court is satisfied that there was no invention upon the part of the plaintiff. There is no suggestion throughout the record that the bar of the plaintiff has met any predetermined engineering demands in concrete construction. Helicoidal bars, wires, hoops and methods of attaching the same to bars for the purpose of keeping apart the several convolutions thereof are old in the art. The attachment of wire to bars or sheets of metal by overlapping spurs of kerfs is old. The patent has no novelty.

It is unnecessary to set forth with any degree of particularity the various patents and publications which have led the court to this conclusion. However, much light may be thrown upon the subject by referring to "Experimental Researches on Reinforced Concrete" by Armand Considere, translated into English and published in New York in 1903.

In the view this court has taken in this case, it is unnecessary to dwell on the subject of infringement. If by any possibility, the patent could be held valid, it is most limited in its scope. If valid and thus limited, there has been no infringement.

The bill of complaint must be dismissed at plaintiff's cost.

APPENDIX D.

VANDENBURGH *v.* ELECTRIC WELDING CO.

(Circuit Court of Appeals, Third Circuit. February 19, 1920. Rehearing Denied March 29, 1920.)

No. 2479.

1. PATENTS (Key) 328—PATENT FOR REINFORCING BAR LIMITED AND NOT INFRINGED.

The Vandenburgh patent, No. 841,741, for a reinforcing bar for use in concrete work, *held* limited by the prior art to a bar with kerfs or cuts, in which the attached coil is placed and a tongue or spur, overlapping the kerf and holding the coil in place; and, as so limited, not infringed.

2. PATENTS (Key) 328—REISSUE PATENT FOR REINFORCING BAR HELD INVALID AS NOT WARRANTED BY ORIGINAL PATENT.

Claims 1 and 2 of the Vandenburgh reissue patent, No. 14,182, for reinforcing bars for use in concrete work, *held* invalid, as not warranted by the original patent.

Appeal from the District Court of the United States for the Western District of Pennsylvania; Charles P. Orr, Judge.

Suit by George E. Vandenburgh against the Electric Welding Company. From a decree dismissing the bill, plaintiff appeals. Affirmed.

Carlos P. Griffin, of San Francisco, Cal., for appellant.

Frederick W. Winter, of Pittsburgh, Pa., for appellee.

Before BUFFINGTON and WOOLLEY, Circuit Judges, and MORRIS, District Judge.

(Key)—For other cases see same topic & KEY-NUMBER in all Key-Numbered Digests & Indexes.

BUFFINGTON, *Circuit Judge.* On January 22, 1907, there was issued to George E. Vandenburgh patent No. 841,741, for a reinforcing bar. On August 15, 1916, a reissue of said patent was granted, No. 14,182. This reissue made no change from the original, either in the specification, in the figures, or in claim 3, here in issue; but claims 1 and 2, here in issue, are new. Vandenburgh having charged the Electric Welding Company with infringing said three claims of the reissue, and the court below having, on final hearing, held the claims invalid and dismissed the bill, Vandenburgh took this appeal.

(1) After argument and due consideration, we are of opinion the court below made no error in dismissing the bill. The grounds of our conclusion we now record:

The combination device, which Vandenburgh disclosed in his specification, was a particular type of attachments of coils and reinforcing bars in concrete work. Both coils of wire and reinforcing bars to which such coils were attached were prior devices in use in that art. Taking these two familiar devices of coil and bar, Vandenburgh disclosed a new way of attaching the coil and bar for use in the concrete reinforcing art, to wit, by the use of kerf or cut in the side of the bar in which the coil was placed, and a tongue or spur overlapping the kerf, which spur, when bent down, served to hold the coil in place. This seating of the bar in the kerf cut and keeping it in place by the overlapping spur or tongue, Vandenburgh set forth in his specification as follows:

> "As a preferred means of securing the coils to the bar I have shown a series of kerfs 8 in *one face of the bar* inclined away from the center of the bar toward the opposite ends thereof, and the coils are seated within these kerfs and *held therein* by means of the integral spurs 9, *which are forced downward*

upon the coils when inserted and *permanently retain them in position*"

—and embodied in his third claim as follows:

> "A reinforcing bar provided upon *one end* with a series of kerfs, each having an integral overlapping spur, and a coil disposed in said kerfs; each convolution thereof being retained beneath one of said spurs."

Now, while a kerf or cut in the edge of a bar was a common mechanical expedient, no one had used it in concrete reinforcement until Vandenburgh disclosed his device. But, other than a combination using a kerf, Vandenburgh disclosed nothing new in his specification. Finding his kerfed combination novel, regarding it as useful, and assuming for present purposes, as we will, that it embodied invention, there is no reason for regarding it as other than a narrow contribution to the art of a specific type of coil and bar attachment. In the nine years between its grant and the filing of this bill, Vandenburgh's patent made no impress in the art, and we give the patentee the full measure of his disclosure and the protection of his claim by limiting his field of monopoly to a reinforcing bar with a kerf and an integral overlapping spur, as embodied in his third claim.

Thus limited, such claim is not infringed by the defendant's structure. It has coils, which, as we have seen, are old; it has a reinforcing bar, which is also old; and the two are attached, but the crux is: How are they attached? Are they attached by a kerf cut? Mere attachment of bar and coil were old, and Vandenburgh's advance consisted, not in bar and coil attachment generally, but in the kerf and spur attachment. This form of attachment being the gist of Vandenburgh's patent, it must be the test of defendant's infringement, or, in

other words, does the defendant use the kerf and spur attachment of Vandenburgh's claim? In our judgment, it does not. The kerf of the claim is upon one end, which can only mean one edge of the reinforcing bar, which end or edge cut is the only form of bar and kerf cut disclosed by Vandenburgh, and his bar is a flat bar, and the kerfs are cut diagonally into the edge of such flat bar. On the other hand, the bar of the defendant's device consists of a channel bar and there is no cut of any kind in the end or edge of either of the channel sides. On the contrary, attachment in defendant's bar is made by using the back body of the central bar of the channel and stamping a tongue out of said solid central back portion, and then winding such tongue over the coil, which does not rest in the body of the bar but outside of it.

It will thus be seen the defendant's coil is not restrained by the body of the bar, or by the sides of any cut in the body of the bar, but is restrained wholly by the tongue, which surrounds and holds the coil. In Vandenburgh's structure, the tongue or spur simply holds the coil in the kerf recess, and it is the cut sides of the kerf which hold the coil in place. If Vandenburgh's spur or tongue broke, the kerf sides would still have a coil-restraining function. But in defendant's device the sides of the cut in the body structure do not restrain or hold the coil; that is the function of the stamped cut, coil-encircling tongue. If defendant's tongue broke, there would be absolutely no coil and bar attachment or restraint, for the cut in the bar has no functional purpose whatever, save to create a tongue, and the attaching, functional agency of defendant's tongue would be the same if no cut in the reinforcing bar were made but the tongue was made by riveting it on the reinforcing bar. For these reasons we are clear defendant's structure does not infringe the third claim.

(2) Seeing, then, that the kerf and overlapping spur in combination constituted the real invention of Vanden-

burgh, and that he disclosed no other form of attachment, it is quite evident he was not entitled to broad claims of the generic type, which he secured on the reissue in claims 1 and 2. Kerf and overlapping spurs are not embodied in these claims, and it is manifest that these claims, unrestricted by the limitation of kerfs and spur, were only added 9 years after his patent was granted, to make infringers of those who used other forms of attachment than the kerf and overlapping spur, which alone Vandenburgh disclosed, and which were the sole warrant for the grant of his patent.

Such being the case, it is clear the court below was not in error in dismissing the bill.

APPENDIX E.

IN THE

DISTRICT COURT OF THE UNITED STATES,

NORTHERN DISTRICT OF OHIO—EASTERN DIVISION.

GEORGE E. VANDENBURGH, *Complainant,* *vs.* TRUSCON STEEL COMPANY, *Defendant.*	In Equity. No. 500.

WESTENHAVER, *District Judge.*

Plaintiff's bill is in the usual form, charging infringement by defendant of United States Re-issue Letters Patent No. 14,182 granted to him August 15, 1916, being a re-issue of letters Patent No. 841,471, granted January 22, 1907. The subject of the patent is for a reinforcing bar to be used in concrete construction. On this hearing, claims 1 and 3 only are in issue and relied on. The defenses are invalidity for lack of invention, and non-infringement.

This re-issue patent has been the subject of previous litigation in the Second and Third Circuits. Circuit Judge Hough, May 13th, 1918, held, in effect, that claims 1 and 2 of the re-issue patent are invalid if the change made therein from the words "rigidly secured" of the original patent, to "permanently secured" of the re-issue claims embody a different meaning than the original; that claim 3 was not infringed by a construction substantially, if not exactly, similar to the construction here involved; and, finally, that the only invention disclosed by

the specifications is the exact construction described and pictured in Figs. 1 and 6. On appeal, the Circuit Court of Appeals of the Second Circuit held that claims 1 and 2 of the re-issue were invalid as too broad, and, in effect, that claim 3 was valid and infringed. The opinion is brief and contains no review of the prior art. It seems to assume that Judge Hough had disposed of the controversy below on the ground only of non-infringement; and seems to assume rather than to attempt to demonstrate that the feature found to be novel as disclosed by the specifications and covered by claim 3 was, in view of the prior art, patentably novel.

In the Third Circuit, District Judge Orr, December 6, 1918, also held that claims 1 and 2 were invalid because too broad, as stated in the opinion of the Court of Appeals, Second Circuit, and also held that claim 3, in view of the prior art, was invalid for lack of invention. On appeal, the Circuit Court of Appeals agreed that claims 1 and 2 were invalid because too broad, but, assuming the validity of claim 3, held that, being limited, as it must, in view of the prior art, to the specific construction therein disclosed and claimed, was not infringed by a construction somewhat different from the construction here involved. We do not understand this opinion as deciding that claim 3 was valid.

On the hearing before me, the controversy was directed almost entirely to the validity of claim 3, although claim 1 was likewise in issue and relied on. In view of the attitude thus assumed by plaintiff's counsel, and the further fact that all the judges who have heretofore considered and passed on claims 1 and 2 have held them to be invalid because too broad, I shall adopt that conclusion without further statement of my reasons than to say that I fully agree both in the conclusion reached and in the reasons given to support it.

Plaintiff's invention is described in his patent as being a reinforcing bar particularly adapted for cement and concrete construction wherein the bar is embedded in the

plastic body to be supported thereby. Fig. 6 discloses an adaptation of this reinforcing bar for column or pillar construction, but no contention is made that this is infringed by defendant. Fig. 4, plaintiff contends, also discloses an adaptation of this reinforcing bar for column construction, and that this is also infringed. This contention is disputed, defendant insisting that Fig. 4 is a detail only of a simple and inexpensive form of the beam construction disclosed in Fig. 1. Assuming without admitting plaintiff's contention to be true, Fig. 4 shows merely a bar with a spiral coil attached to the bar at each convolution by a kerf inclined at an angle to the edge of the bar in such a way as to produce an overlapping integral spur, with this spur hammered down so as to hold rigidly this spiral. Defendant makes and sells a collapsible spiral used in strengthening concrete column or pillars. It consists of a cylindrical spiral of steel wire usually fitted to two bars or spacers, with each convolution of the spiral engaging the spacers at regular intervals. The engagement is so loose fitting that this construction, which is normally stove-pipe-shaped, can be made flat for shipment by moving the metal rods or spacers longitudinally in opposite directions. The method whereby the spiral is attached to the spacer bar is a rectangular notch in the bar, with one or both corners peened or hammered down so as to retain and hold loosely the spiral. Fig. 4 and claim 3 of plaintiff's patent, it is contended, embody and cover this construction; hence the charge of infringement.

The differences in the method of attaching the spiral to the bar, the result accomplished, and the special collapsible mode of operation, between defendant's and plaintiff's construction are such that were I to adopt the limited and narrow construction given to claim 3 by the Third Circuit Court of Appeals, I might likewise dispose of this controversy by holding plaintiff's patent not to be infringed. The inclined kerf method of attachment, with an integral overlapping spur holding the spiral rigidly to the reinforcing bar or spacer, is not the exact method of attachment used by defendant. The kerfs or plaintiff's

patent are required to be cut at an inclined angle to the edge of the bar, thereby creating an integral overlapping spur. This kerf and spur when hammered down, the disclosures of the patent show, were intended to and do hold the spiral rigidly or permanently in place. Defendant's spacing bars have merely a rectangular notch cut at right angles in the spacing bar, and when one or both corners are hammered down, the spiral is not held rigidly or permanently in place, but so loosely as to permit of collapsing. These differences in construction are as substantial as those held not to infringe by the Third Circuit Court of Appeals. This, however, seems to me to be too narrow a ground upon which to dispose of this controversy. It seems to me that if plaintiff's patent is valid because novel and useful in a patentable sense, the charge of infringement could not be repelled by such an insubstantial difference in the method of attachment; particularly as plaintiff's patent suggests this method merely as a preferred method. I have therefore given careful consideration to the charge of infringement.

My conclusion is that if Fig. 4 and claim 3 disclose and cover a concrete reinforcement for columns and pillars of the character now claimed by plaintiff and as is constructed and used by defendant and others, the claim must be held void for want of patentable novelty. My reasons for this conclusion may be briefly stated.

Plaintiff's original application was filed May 8, 1906, and this must be taken as the date of his invention. True, on this hearing he offered some testimony is not sufficient, in my opinion, according to well settled rules, to establish an earlier date. The concrete reinforcement art for columns and pillars was at this date quite well developed, although it had not come into such general and extensive use as it now enjoys. This art had been described in standard technical treatises and disclosed in numerous patents and practical constructions. Armand Considere, a French engineer, in a standard work, translated and published in New York in 1903, teaches all that can now be claimed by plaintiff for his

patent or that is now done by the defendant in the matter of buildings and reinforcing concrete columns, except perhaps the kerf and spur method of attaching the spiral to the spacing or reinforcing bar or bars. This is, in fact, admitted by plaintiff. Hoops, circular bands, and continuous spirals attached to spacing or reinforcing bars as a method of concrete reinforcement for columns or pillars is also disclosed by numerous patents. See Hyatt British Patent No. 1715, 1874, Pelegren French Patent No. 323,457, 1902, Considere United States Patent No. 752,523, 1904, Kieserling & Moller German Patent No. 73004, 1892. Similar constructions are also described and illustrated by Christophe in an article published in 1902, by Marquess in an article published in the Engineering News of New York in 1904, and also in other articles and illustrations in the Engineering News of March 8, 1906, and June 15, 1905.

In some the method of attaching the spiral to the bar is also disclosed. Kieserling & Moller, above noted, discloses a notch in the outer edge of the spacing bar designed to contain and hold the coils. Cummings, U. S. Letters Patent No. 822,587, application dated January 6, 1905, patent date June 6, 1906, shows circular, but not spiral, reinforcing bands for a concrete column attached to the spacer bars by tongues stamped out and then pressed and hammered down over the bands. Christophe, in the article above referred to, discloses notches on the exterior faces of the spacing bars to contain and hold the spiral.

In the metal working arts, numerous patents disclose kerfs or notches, including inclined kerfs with overlapping spurs, as a means of attaching coils or spirals to bars. See the following U. S. Letters Patent: Norwood, No. 601,575, 1896; Clark, No. 589,593, 1897; Carson, No. 278,282; McCall, No. 657,827; Caldwell, No. 682,386, 1901; Prescott & Bennett, No. 447,162, 1891, and Enson, No. 723,632, 1903. Of these patents, Norwood and Eason disclose the inclined kerf with the overlapping integral spur, and Prescott & Bennett discloses a rectangular notch or kerf cut at right angles to the edge of the bar

with the corners hammered down in the manner of defendant's construction.

Thus it appears that all the elements, both of claim 3 of plaintiff's patent and of defendant's construction, are old. Plaintiff's counsel, as already said, admits this to be true, but contends that the reinforced concrete art does not show the kerf and spur in a combination with reinforcing or spacer bar or bars and a continuous spiral, and that this novelty is of a patentable character. This claim of novelty is not true in view of Kieserling & Moller and Christophe's disclosure unless plaintiff's kerf is to be limited to a kerf inclined at such an angle to the edge of the spacer bar as to create and form an integral overlapping spur. It is the latter method only of attachment which is not plainly shown in the prior art. The numerous examples of hoops, circular bands, and continuous spirals in combination with spacing or reinforcing bars found in the concrete art do not explicitly call for an inclined kerf and integral overlapping spur method of attachment. Notches in which to seat and hold the spiral are, however, called for and disclosed. Doubtless, engineers like Considere, Christophe, and Marquess, as well as numerous inventors, assume that any reasonably skilled mechanic or engineer would know the means used and available in the metal working art to accomplish this result, and regarded it as unnecessary to make further disclosures or to give more specific directions. Plaintiff's contention, however, now is that any kind of kerf or notch is covered by his patent, and this claim comes in conflict literally with the existing prior art.

Furthermore, invention cannot, in my opinion, be based on the adaptation of the familiar inclined kerf with an integral overlapping spur of the metal working art to its assumed new use in the concrete reinforcing art. Let it once be assumed, as plaintiff's counsel concedes, that the concrete reinforcing art teaches that the proper method of reinforcing a concrete column or pillar is to use hoops or circular bands, or continuous spirals, spaced at regular intervals around spacer or reinforcing bars and attached hereto, then the problem of making this

attachment becomes no longer one peculiar to the concrete reinforcing art but belongs to the metal working art. The problem is one of the metal worker, and not of the concrete engineer. For this reason, all the means known to the latter art or used by workers therein, must be regarded as the common possession of all persons skilled in either art, and invention cannot be predicated upon a transfer of a device familiar in one to a like use in the other; particularly is this true when no new principle of operation, and no new function is accomplished or performed as a result of the transfer to the new combination.

That invention is not present under these conditions, and does not result from such an adaptation of an old device, is well settled by numerous decisions. See Huebner-Toledo Breweries Co. *vs.* Mathews Gravity Carrier Co. (6 C. C. A.) 253 Fed. 435; Berger Mfg. Co. *vs.* Trussed Concrete Steel Co. (6 C. C. A.) 257 Fed. 741; Van Dorn Iron Works Co. *vs.* Mathis Bros. Co. (6 C. C. A.) 260 Fed. 400, 405-6. The language of Judge Warrington in the case first cited, is equally applicable here. "It must, of course, be conceded that patentable novelty may exist in a combination of old elements; but here the combination claims in suit are lacking in the usual and essential tests of invention. No new function of elements or new method of operation is evolved, and the result achieved is exactly the same as the old one. The settled rule under such facts is that to adapt an old and familiar device to another structure equally old and well known is not to exercise the inventive faculty; it is to apply the skill of the mechanic."

Plaintiff made his alleged invention in an art already crowded and highly developed. The evidence shows that commercially he has contributed nothing whatever to the progress of reinforced concrete construction. No buildings or column were ever constructed by any one under his patent prior to 1916. Two licenses only have been issued by him, the first in the latter part of 1916, under which no business appears to have been done except perhaps to put up one structure, and the other followed the

favorable decision in the Second Circuit. Claim 3 of his patent consequently is only another example of that class of patents described by Mr. Justice Bradley in Atlantic Works *vs.* Brady, 107 U. S. 192, (and recently approved and re-announced by Mr. Justice Clarke in Elyria Iron & Steel Co. *vs.* Railway Supply Co., 242 U. S. 609, in these words: "The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle and injurious in its consequences." See also Railroad Supply Co. *vs.* Elyria Iron & Steel Co. 244 U. S. 285; Package Mach. Co. *vs.* Johnson Automatic Sealer Co. (6 C. C. A.) 246 Fed. 598, 601; A. Schrader's Son, Inc. vs. Dill Mfg. Co. (6 C. C. A.) 262 Fed. 504.

This conclusion is reached on the assumption that plaintiff's patent and claim 3 discloses what is claimed to be his invention. Personally, however, I agree also with Judge Hough's conclusion that plaintiff's invention was not what he now claims and that what is now claimed is not thereby disclosed, but that the only invention disclosed by his specifications and claims is the exact construction described and pictured in Figs. 1 and 6, as to which no charge of infringement is made.

For these reasons plaintiff's bill will be dismissed at his costs.

D. C. WESTENHAVER,
Judge.

Cleveland, Ohio,
September 23, 1920.

APPENDIX F.

UNITED STATES COURT OF CLAIMS

No. 195-A.

GEORGE E. VANDENBURGH,
Petitioner,

vs.

THE UNITED STATES,
Defendant.

PETITION.

ON REISSUED LETTERS PATENT
No. 14,182.

To the Honorable, the Judges of the United States Court of Claims:

The petition of George E. Vandenburgh respectfully represents:

I. That your petitioner is a citizen of the United States, and is a resident of the City of Sacramento, in the County of Sacramento and State of California, United States of America; and brings this action in his own right.

II. That this petition is filed against the United States under and pursuant to the provisions of the Act of Congress, approved June 25, 1910, entitled, "An Act to Provide Additional Protection for the Owners of Patents of the United States and for Other Purposes," as amended by the Act of Congress, approved July 1, 1918.

III. That heretofore and before the 9th day of May, 1906, your petitioner was the true, original and first inventor of certain new and useful improvements in reinforcing bar, not known or used by others in this country before his invention or discovery thereof, not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application for a patent in this country therefor, not patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than twelve months prior to said application for patent in this country, and not in public use or on sale in this country for more than two years prior to his said application for patent in this country; and so being the true, original and first inventor thereof, your petitioner made due application, according to law, for Letters Patent of the United States therefor; and on the 22nd day of January, 1907, upon his said application and in conformity to law, Letters Patent, in the name of the United States of America, dated January 22nd, 1907, No. 841,741, duly executed and recorded, sealed with the seal of the Patent Office and signed by the Commissioner of Patents, according to law, were duly granted to your petitioner, whereby there was granted and secured or intended to be granted and secured to your petitioner, his heirs and assigns, for the term of seventeen years from and after the said 22nd day of January, 1907, the exclusive right to make, use and vend throughout the United States and the Territories thereof, the invention aforesaid, a description whereof, in the words of your petitioner, was given in the schedule annexed to said Letters Patent and made a part thereof, as by reference to said Letters Patent, or to a duly authenticated copy thereof, here in court to be produced, will more fully and at large appear.

IV. That thereafter it appeared to your petitioner that said Letters Patent were defective and insufficient

by reason of the fact that your petitioner had claimed more than he had a right to claim as new, and by reason of the fact that the verbiage of the claims was defective in not precisely corresponding with the terms of the specifications, whereupon on, to wit, July 1st, 1916, being then sole owner of all right, title and interest in said patent, your petitioner prepared in accordance with law and filed an application with the Commissioner of Patents of the United States to have said patent reissued; that thereafter due proceedings were had by the United States Patent Office, and in regular course said patent was reissued and was delivered to your petitioner granting to him rights of the same effect and operation in law as if the same had been originally filed in such correct form, and that the errors or mistakes in the original patent arose by accident or inadvertence and without fraudulent or deceptive intention on the part of your petitioner.

V. That said Reissued Letters Patent were granted in due form of law under the seal of the United States Patent, and were signed by the Acting Commissioner of Patents, and bear date of August 15th, 1916, under the number 14,182, and that all requisite proceedings were had prior to the reissue of said Letters Patent which are required by law in such cases, and profert is hereby made of said reissued Letters Patent, or a certified copy thereof, for a more complete and full description of the invention covered thereby; and that your petitioner is now the sole owner of all right, title and interest to said reissued Letters Patent.

VI. That your petitioner has never assigned, nor granted any right, title or interest, whatsoever, in or to the said invention, or in or to said reissued Letters Patent No. 14,182, but still holds and owns the entire exclusive right, title and interest in and to said invention and Letters Patent, and in and to all rights of action for the past or future infringement of said reissued Letters Patent.

VII. That your petitioner is advised and believes, and therefore avers, that said reissued Letters Patent No. 14,182, are valid and effective in law to secure to your petitioner the exclusive rights and privileges thereby granted; that so far as your petitioner is informed and believes, the public generally have acquiesced in your petitioner's rights under said reissued Letters Patent; that your petitioner is entitled to the exclusive use and enjoyment of said invention and of said reissued Letters Patent; and that, but for the infringement hereinafter complained of and those of like character, your petitioner would have been and would now be, in the undisturbed possession, use and enjoyment of the said invention and of the said exclusive rights and privileges and in receipt of the profits of the same.

VIII. That the invention covered and claimed in said reissued Letters Patent No. 14,182 was not invented or discovered by your petitioner, while an employee of the Government of the United States, nor during the time of his employment or service by or for the Government of the United States, nor is your petitioner now in the employment or service of the Government of the United States.

IX. That your petitioner is informed and believes, and therefore avers, that the United States, through the officers and employees of its War and Navy Departments, and otherwise, has, since the grant of said reissued Letters Patent No. 14,182, and before the filing of this petition, without the license of your petitioner, or without lawful right, made and constructed or caused to be made and constructed and used, or caused to be used, reinforcing bars containing and embodying the invention covered and claimed by said reissued Letters Patent No. 14,182, and particularly by Claims 1, 2, 3, 4 and 5, thereof, in violation and infringement of said reissued Letters Patent and of the rights of your petitioner thereunder; that such unlawful and unauthorized use of your petitioner's

said invention has resulted in great injury, damage and loss to your petitioner, to wit, as your petitioner is informed and believes, and therefore avers, the aggregate sum of Five hundred thousand dollars ($500,000) damages, which sum is still due your petitioner, no part thereof having been paid, and which sum or such reasonable compensation for the use by the United States of your petitioner's said invention as this Honorable Court may find to be due your petitioner, your petitioner avers he is fully entitled to recover from the United States, after allowing all credits and offsets.

X. That your petitioner's said claim for compensation for the use of his said invention is not based on the use by the United States of any article, apparatus or method, owned, leased, used or in the possession of the United States prior to June 25th, 1910.

XI. That your petitioner has not sold or transferred his said claim or any part of the same to any person or persons; that no action has been taken on this claim in Congress or in any of the departments; that your petitioner has not, in any way, voluntarily aided, abetted or given encouragement in rebellion against the Government of the United States.

XII. That the facts stated in this petition are true.

WHEREFORE, your petitioner prays judgment in his favor against the United States, for the sum of Five hundred thousand dollars ($500,000) and for such other and further relief as to the Court may seem just.

GEORGE E. VANDENBURGH.

O. ELLERY EDWARDS,
Woolworth Building,
New York City,
Attorney and of Counsel for Petitioner.

STATE OF CALIFORNIA, } ss.:
County of Sacramento, }

GEORGE E. VANDENBURGH, being duly sworn, according to law, says: that he is the petitioner named in the foregoing petition by him subscribed; that he has read the said petition and knows the contents thereof; that the said petition is true of his own knowledge, except as to matters therein stated to be on information and belief, and as to such matters he verily believes it to be true.

GEORGE E. VANDENBURGH.

Subscribed and sworn to before me this 4th day of June, 1921.

R. H. MAYHARD,
Notary Public.